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Louis Casteilla

SERVIER 507 PCT

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09/30/2009

THE FIRM OF HUESCHEN AND SAGE  
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EXAMINER

STOCKTON, LAURA LYNNE

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

09/30/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



**DETAILED ACTION**

Claims 17-29 are pending in the application.

***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Due to the numerous variables in the claims, e.g. X, B, D, R<sup>1</sup>, R<sup>3</sup>, R<sup>5</sup>, etc., and their widely divergent meanings, a precise listing of inventive groups cannot be made. The following groups are exemplary:

**Group I**, claim(s) 17, 18, 20 and 21, drawn to a pharmaceutical composition wherein the substance which promotes lipid and carbohydrate metabolism is a compound of formula (I) wherein **X** is oxygen atom and **D** is a benzene nucleus.

**Group II**, claim(s) 17-23, drawn to a pharmaceutical composition wherein the substance which promotes lipid and carbohydrate metabolism is a compound of formula (I) wherein **X** is sulphur atom and **D** is a benzene nucleus.

**Group III**, claim(s) 17, 18, 20 and 21, drawn to a pharmaceutical composition wherein the substance which promotes lipid and carbohydrate metabolism is a compound of formula (I) wherein **X** is  $\text{CH}_2$  or  $\text{CH-R}'^2$  and **D** is a benzene nucleus.

**Group IV**, claim(s) 24-29, drawn to methods of using a pharmaceutical composition wherein the substance which promotes lipid and carbohydrate metabolism is a compound of formula (I) wherein **X** is oxygen atom and **D** is a benzene nucleus.

**Group V**, claim(s) 24-29, drawn to methods of using a pharmaceutical composition wherein the substance which promotes lipid and carbohydrate metabolism is a compound of formula (I) wherein **X** is sulphur atom and **D** is a benzene nucleus.

**Group VI**, claim(s) 24-29, drawn to methods of using a pharmaceutical composition wherein the substance which promotes lipid and carbohydrate metabolism is a compound of formula (I) wherein **X** is  $\text{CH}_2$  or  $\text{CH-R}'^2$  and **D** is a benzene nucleus.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Again, this list is not exhausted as it would be impossible under the time constraints due to the sheer

volume of subject matter instantly claimed. Therefore, applicant may choose to elect a single invention by identifying another specific embodiment not listed in the exemplary groups of the invention and the examiner will endeavor to group the same.

The inventions listed as Groups I-VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features that defines a contribution over the prior art. The claimed pharmaceutical compositions contain: (i) a substance which is useful in promoting lipid and carbohydrate metabolism, (ii) an antioxidant agent, and (iii) optionally a carrier or excipient. No class of compounds, formula or structure is provided in independent claim 17 for the (i) substance. Therefore, there is no special technical feature present. Accordingly, unity of invention is considered to be

lacking and restriction of the invention in accordance with the rules of unity of invention is considered to be proper.

Additionally, the vastness of the claimed subject matter (see instant claim 17) and the complications in understanding the claimed subject matter imposes a burden on any examination of the claimed subject matter.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no

longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35

U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.



The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be

amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (571) 272-0710. The examiner can normally be reached on Monday-Friday from 6:00 am to 2:30 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (571) 272-0699.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 1626

The Official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

/Laura L. Stockton/

Laura L. Stockton

Primary Examiner, Art Unit 1626

Group 1620

Technology Center 1600

September 30, 2009